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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/042,447 | 01/08/2002 | Stephan Oliver Mietens | PHNL 010028 | 4625 |

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

LERNER, MARTIN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2654

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,447

Applicant(s)

MIETENS ET AL.

Examiner

Martin Lerner

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 to 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 14 to 18 set forth the limitation that for a given coefficient the calculation cost is "not greater than prior selected coefficients costs", which involves new matter because there is no disclosure of the limitation in the originally-filed Specification. Indeed, the cited limitation is directly contrary to Applicants' Specification.

Applicants' Remarks point to support for the limitation as found on Page 9, Lines 12 to 20, of the Specification, which state, "Using this database, we focus on finding the next DCT coefficient that needs the least operations, depending on the calculations already done. This will give an algorithm-dependent calculation order of the coefficients . . . which leads to less remaining calculation cost for B_1 than B_3 in the second step.

This can be seen in Table 2, where the database of Table 1 has been updated by the information, that B_2 has been calculated.”

However, the originally filed Specification does not say either expressly or implicitly that a given coefficient has a calculation cost that “is not greater than prior selected coefficient calculation costs”. Instead, the Specification discloses finding the next coefficient that needs the least operations, based on calculations already done. The next coefficient to be calculated has the next least great cost in a progression from a least calculation cost to a next least calculation cost, given shared calculation costs of prior calculations already performed. If a calculation cost of a coefficient is “not greater than prior” coefficient calculation costs, then that coefficient would already be calculated according to Applicants’ algorithm-dependent calculation order, which requires starting with a coefficient that has a least calculation cost and then progressively calculating a coefficient with a next greater calculation cost, given shared calculation costs between coefficients.

Applicants’ Specification, Page 9, discloses that coefficient B_2 is calculated first because a calculation cost involves only three operations, whereas coefficient B_1 and coefficient B_3 both involve calculation costs of four operations. (Table 1) Then, given that the operations for coefficient B_2 are already performed, the calculation cost of coefficient B_1 is reduced to three operations and the calculation cost of coefficient B_3 remains at four operations. (Table 2) Thus, coefficient B_1 is calculated next, because the calculation cost is less than that for coefficient B_3 , but it is noted that the calculation cost of coefficient B_1 is three operations, which is neither greater nor lesser than the

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prior calculation cost for coefficient B_2 , which was also three operations. In general, one would not expect that a calculation cost for a next coefficient would necessarily be either greater or lesser than a calculation cost for a prior coefficient already calculated, just that a lesser calculation cost of remaining coefficients determines a next coefficient to be calculated. For example, if original calculation costs for coefficients B_1 , B_2 , and B_3 were 6, 3, and 7, respectively, then coefficient B_2 would be calculated first, but then post-shared calculation cost of coefficients B_1 and B_3 could conceivably be 1 and 2, respectively, could remain at 6 and 7, respectively, or could be reduced to 4 and 5, respectively.

Therefore, Applicants' claim language of a calculation cost of a given coefficient "is not greater than prior selected coefficient calculation costs" is new matter because there is neither any express or implied disclosure of the limitation in the originally-filed Specification.

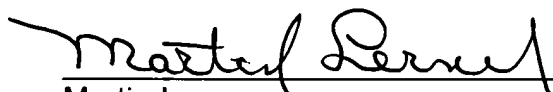
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (571) 272-7608. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (571) 272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
9/12/05


Martin Lerner
Examiner
Group Art Unit 2654